



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: NISHIDA et al.

Serial No.: 10/081,800

Filed: February 22, 2002

For: IN-PLANE SWITCHING MODE ACTIVE MATRIX

Group: 2871

Examiner: JEANNE A. DI GRAZIO

DOCKET: DEC A337

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT A

Dear Sir:

This Amendment is being filed in response to the Official Action mailed July 2, 2003.

Provisional election is hereby made, with traverse, to prosecute the invention of Group I, comprising claims 1-118.

The restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the requirement for election. The Official Action states:

"In the instant case, the product is capable of being made by a different process, for example, by a process different than etching to form a contact hole."

However, the Examiner makes no suggestion as to an alternative process. Simply saying that a product may be made by a different process without offering a different process does not make it so!

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent

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fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements not having been met here vis-à-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicant provisionally elects to prosecute Group I, i.e., claims 1-118, and it is requested that, without further action thereon, the remaining claims be retained in this Application pending disposition of the Application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

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In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 28, 2003, at Tucson, Arizona.

By 

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